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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,408	04/09/2004	Kerry Sellen	020375-034510US	8430
20350 7590 07/22/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER NGUYEN, HIEP VAN				
ART UNIT 3626		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/821,408

**Applicant(s)**

SELLEN ET AL.

**Examiner**

HIEP NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-28 have been examined. Claims 29-55 have been cancelled.

#### ***Response to Amendment/Arguments***

2. Independent claims 1 and 17 have been amended to include limitations directed to "defining an alternative resolution strategy", "applying the special rule", and "transactions of the customer".
3. In the remarks filed 05/12, 2008, Applicants argue that Templeton does not disclose (1) determining whether the promissory payment can be submitted for subscriber settlement by evaluating to a special rules database defining an alternative resolution strategy, (2) submitting the promissory payment to the customer's financial institution if it is determined that the transactions of customer are not subject to a special rule.
4. In response to Applicant's argument (1), the Examiner respectfully disagrees that inaction on the part of defining an alternative resolution strategy. Since Templeton discloses the transaction of customer submitted for subscriber settlement by evaluating the promissory information through the access settlement path determination. Therefore given the broadest reasonable interpretation to one of ordinary skill in the art, it is submitted that the access settlement path determination is a form of an alternative resolution strategy.
5. Furthermore in Applicant's argument (2), Templeton discloses evaluating the risk of accepting the promissory payment based on the selective use of DDA information.

Therefore, given the broadest reasonable interpretation to one of ordinary skill in the art, it is submitted that the selective use of access DDA path is a form of a special rule for submitting and applying the transaction of customer.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claims 1 recites the limitation "the transactions of the customer" in line 10. There is insufficient antecedent basis for this limitation in the claims.
9. Claims 2-16 are rejected as each depends from Claim 1.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Templeton et al. (US 2003/0130919.)

3. With respect to claim 1, Templeton et al. teaches a method of processing electronic promissory payments made by a customer to a merchant, the method comprising:

- a. receiving an electronic representation of a promissory payment that includes an identification of the customer account and the merchant (Page 1, paragraph 0006, lines 2-5, Abstract, line4.)
- b. determining whether the payment can be submitted for subscriber settlement by evaluating a special rules database to determine whether the customer's transactions are subject to a special rule (Paragraph 0007, lines 6-7. Paragraph 0081, lines 1-15.)
- c. submitting the payment to the customer's financial institution electronically if it is determined that the customer's electronic representation is not subject to a special rule; and submitting the payment to the customer's financial institution according to the special rule if it is determined that the customer's electronic representation is subject to a special rule (Paragraph 0009, lines 1-15.)

4. With respect to claim 2, Templeton et al. evaluating the special rules database includes identifying the customer's financial institution associated with at least one of an account number, a routing number, and an alternative routing number (Paragraph 0081, lines1-15.)

5. With respect to claim 3, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises printing the electronic

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representation of the payment as a paper drafted check for submission to the clearing house (Paragraph 0160, lines 1-7.)

6. With respect to claim 4, Templeton et al. teaches submitting the payment to the customer's financial institution includes submitting the paper drafted check to the customer's financial institution (Paragraph 0157, lines 1-6, Paragraph 0160, lines 1-7.)

7. With respect to claim 5, Templeton et al. teaches submitting the payment to the customer's financial institution includes submitting a pre-authorized check or PAC item (Paragraph 0050, lines 1-15.)

8. With respect to claim 6, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises submitting the electronic representation of the payment to the customer's financial institution via a direct electronic access system (Paragraph 0089, lines 8-12, Paragraph 0058, lines 9-14.)

9. With respect to claim 7, Templeton et al. teaches submitting the payment to the customer's financial institution includes submitting the electronic representation of the payment to the customer's financial institution via the direct electronic access system (Paragraph 0058, lines 9-14.)

10. With respect to claim 8, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises the use of an alternative routing transit number (Paragraph 0088, lines 1-8.)

11. With respect to claim 9, Templeton et al. teaches submitting the payment includes submitting the payment to the customer's financial institution using the alternative routing transit number (Paragraph 0089, lines 9-12.)

12. With respect to claim 10, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises the use of an alternative account number (Paragraph 0088, lines 1-8.)

13. With respect to claim 11, Templeton et al. teaches submitting the payment includes submitting the payment to the customer's financial institution using the alternative account number (Paragraph 0088, lines 1-8.)

14. With respect to claim 12, Templeton et al. teaches receiving electronic promissory payments comprises generating an electronic profile relating to the customer using electronic check conversion (Paragraph 0162, lines 1-10.)

15. With respect to claim 13, Templeton et al. teaches submitting the customer's electronic representation to the customer's financial institution comprises transferring funds from the customer's account using electronic fund transfer (Paragraph 0058, lines 9-14.)

16. With respect to claim 14, Templeton et al. teaches submitting the customer's electronic representation to the customer's financial institution directly comprises transferring funds from the customer's account direct connect, On-Us processing (Paragraph 0058.)

17. With respect to claim 15, Templeton et al. teaches the method further comprises performing a risk assessment relating to processing electronic promissory payments using the electronic representations of the promissory payments (Abstract, lines 1-6.)

18. With respect to claim 16, Templeton et al. teaches updating the special rules database in a manner so as to record previous submissions by the customer (Paragraph 0081, lines 1-15.)

19. With respect to claim 17, Templeton et al. teaches a method of settling a financial transaction between a customer and a merchant using a routing mechanism (Paragraph 0089, lines 1-13), the method comprising:

acquiring an electronic profile relating to the customer, wherein the electronic profile can be used to transfer funds from the customer's financial institution (Paragraph 0025, lines 1-4);

evaluating the electronic profile using a special rules database having previously stored electronic information relating to the customer in a manner so as to identify a special rule; and requesting settlement of the financial transaction with the customer's financial institution using at least one of the electronic profile and the special rule, wherein the special rule identifies the manner in which the funds can be transferred from the customer's financial institution (Paragraph 0088, lines 4-8.)

20. With respect to claim 18, Templeton et al. teaches identifying the special rule includes identifying that the financial transaction requires printing of a paper drafted check (Paragraph 0160, lines 1-7.)

21. With respect to claim 19, Templeton et al. teaches printing the paper drafted check includes printing a drop-to-draft check (Paragraph 0160, lines 1-7.)



22. With respect to claim 20, Templeton et al. teaches requesting settlement of the financial transaction comprises submitting the printed paper drafted check to the clearing house to settle the financial transaction (Paragraph 0160, lines 1-10.)
23. With respect to claim 21, Templeton et al. teaches identifying the special rule includes identifying that the financial transaction requires the use of a direct electronic access system Paragraph 0089, lines 8-12, Paragraph 0058, lines 9-14.)
24. With respect to claim 22, Templeton et al. teaches requesting settlement of the financial transaction comprises submitting the electronic profile to the customer's financial institution using the direct electronic access system (Paragraph 0058, lines 9-14.)
25. With respect to claim 23, Templeton et al. teaches evaluating the special rules database includes evaluating pre-recorded electronic information relating to either the customer or the customer's financial institution (Paragraph 0086, lines 1-14.)
26. With respect to claim 24, Templeton et al. teaches evaluating the pre-recorded information comprises evaluating a previous check writing history relating to either the customer or the customer's financial institution (Paragraph 0089 lines 6-12.)
27. With respect to claim 25, Templeton et al. teaches identifying either the customer or the customer's financial institution associated with at least one of an account number, a routing number, and an alternative routing number (Paragraph 0081, lines 1-15.)
28. With respect to claim 26, Templeton et al. teaches the method further comprises generating a risk score indicative of the risk associated with the financial transaction (Paragraph 0093, lines 1-5).

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29. With respect to claim 27, Templeton et al. teaches updating the special rules database in a manner so as to record previous electronic profiles relating the customer (Paragraph 0089, lines 1-13.)

30. With respect to claim 28, Templeton et al. teaches evaluating the electronic profile further comprises developing at least one special rule relating to at least the customer (Paragraph 0089, lines 1-13.)

***Claim Rejections - 35 USC § 103***

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton et al. in view of Allan (US 2003/0055756.)

33. With respect to claim 14, Templeton et al. teaches submitting the customer's electronic representation to the customer's financial institution directly comprises transferring funds from the customer's account direct connect, On-Us processing. However, Templeton et al. does not direct show account direct connecting, On-us processing. Allan teaches an On-us transaction (Page 4, paragraph 0040.) Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Templeton et al. taught by Allan and include Allan's On-us transaction in Templeton et al.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571)270-5211. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HIEP NGUYEN/  
Examiner, Art Unit 3626

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626